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BLANK ROME LLP 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037			YAO, SAMCHUAN CUA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/818,520	Applicant(s) FARQUHAR ET AL.	
	Examiner Sam Chuan C. Yao	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 24 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 7-14, 16, 24 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01-24-05 & 02-17-05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: a reference number for an energy director element 22 is missing in the figures. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The proposed drawing correction and/or the proposed substitute sheets of drawing filed on 09-07-99 have been disapproved because they introduce new matter in the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. While it is acknowledged that, the original discloses a lower energy director (20) and a corresponding energy director element 22 are mated together, and figure 2 shows energy director 20 as having a V-shaped projection, the original disclosure fails to reasonably convey to one in the art that, the corresponding energy director must be a complimentary V-shaped groove. Why not form a frame

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element with a U-shaped groove, a rectangular groove or a rectangular protrusion having a V-shaped or semi-circular groove. Simply because it is disclosed that, the pair of energy directors are mated together, it does not necessarily mean that a projecting element of a member has to be mating member with a groove much less a complimentary groove (i.e. V-shaped) as evidence from the teachings of anyone of Branson publication cited by Applicant (figures 1-5), (Bentley et al (US 6,054,072; col. 5 lines 1-30; figures 3 & 5), Sadowski (US 6,007,069; col. 15 lines 39-67; figures 5, 7-8 and particularly 11); and, Violette et al (US 5,129,787; col. 5 lines 54-68; figures 5-6). For these reasons, original disclosure does not provide sufficient support for an energy director 22, which forms a V-shaped groove to a surface of a frame element.

Claim Objections

3. Claim 28 is objected to because of the following informalities: on line 9 of this claim, "f" should be replaced with --of--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7-14, 16, 24 and 28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 7, the claim recitation of having at least one finger on first and second sides raises an issue of New Matter. The original disclosure teaches providing 1st and 2nd sides of the metal covers with multiple fingers (see element 26 of figure 3). There is no suggestion in the original disclosure of using a finger on 1st and 2nd sides. In fact, in two separate declarations made by Mr. Paul Mercadante and Mr. Mark Moshayedi in Application No. 08/092,012 (now U.S. Patent 5,397,857) Paper No. 7, it was stated in numbered paragraph 4 that *"Duel's products superiority over the other available products is due to the unique construction of the cover halves which interperses a plastic frame within the metal elements or cover. This allows assembly of the package far more rapidly than with other products, and yields a superior package result."* (emphasis added). If there is only a finger on the 1st and 2nd sides of the cover, how can each cover interperses a plastic frame? Moreover, Counsel also argues in Paper No. 6 on pages 3-4 in application '012, the critically of *"protruding metallic fingers"* to the invention as evidence from the following passage *"The technique includes the use of protruding metallic fingers on the cover ... The present invention accomplishes this by means of the multiple fingers 26 ..." (emphasis added).*

In claim 11, the claim recitation of *"with at least one finger extending from each said sides of each cover"* raises an issue of New Matter for the same reasons set forth above. Note: The phrase *"the fingers"* recited in this claim is taken to be referring to a pair of *"at least one finger ..."* (emphasis added) on 1st and 2nd sides of each of two covers, and not a plurality of fingers to each of the 1st and 2nd sides.

In claim 24, the limitations in this claim read on having fingers to all sides of each cover. There is no sufficient support in the original disclosure for this embodiment. As noted above, figure 3 clearly shows that only the 1st and 2nd sides of each cover are provided with fingers. Moreover, this claim also reads on having a finger on all sides of each cover.

In claim 28, the claim recitation of “... *each of the edges including protruding portions, the protruding portions adjacent open portions providing voids*” reads on (for example) an end surface of each of the edges having a plurality of spaced-apart small spherical bumps projecting from the end surface. The original disclosure fails to reasonably convey that Applicant has in possession this newly added subject matter at the time of filing.

Reissue Applications

6. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or accessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

7. Claims 7-14, 16, 24, and 28 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429,

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1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Background:

To determine whether there is an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based, it is imperative to review the record of the parent (S.N. 08/092,102) of this reissue application as a whole. In other words, one must review the cumulative limitations added to the claims as well as the totality of Counsel's arguments to determine whether there is an improper recapture of claimed subject matter.

The invention relates to memory card cover halves, wherein each cover half includes a metal cover having sides from which "*fingers*" extend. The "*fingers*" are embedded in, or otherwise integrally attached to (e.g., by injection molding), a plastic "frame element" also included in each cover half.

The original article claims included the limitation that the "*fingers*" are "*embedded in the plastic frame elements*" (hereinafter, the *embedded fingers limitation*). In response to the examiner's first Office action prior art rejection, applicants amended the independent claim so as to eliminate the *embedded fingers limitation* in favor of a limitation reciting

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“plastic frame elements forming an integral unit” (hereinafter, the *integral frame limitation*) and a limitation reciting “the plastic frame elements being injection molded around the fingers” (hereinafter, the *injection molding limitation*). In addition, on pages 3-4, Counsel argues the criticality of injection molding and “*protruding metallic fingers*” to the invention as evidence from the following passage “*The technique includes the use of protruding metallic fingers on the cover ... The present invention accomplishes this by means of the multiple fingers 26 ...*” (emphasis added). To further emphasize the importance of using multiple fingers, Counsel further submitted two separate declarations made by Mr. Paul Mercadante and Mr. Mark Moshayedi in Application ‘102 Paper No. 7. In both declarations, it was stated in numbered paragraph 4 that “*Duel’s product’s superiority over the other available products is due to the unique construction of the cover halves which intersperses a plastic frame within the metal elements or cover. This allows assembly of the package far more rapidly than with other products, and yields a superior package result.*” (bold face and emphasis added). (There were 35 U.S.C.112, 2nd paragraph, rejections that were made, but the record is clear that the amendments to claim 1 were not made in response to those rejections.) The application was later allowed, with an examiner’s amendment that was required by the examiner.

The following three aspects of the original application prosecution are especially relevant to evaluating recapture in the present reissue.

I. The examiner’s amendment added the *embedded fingers limitation* back into the independent claim. In addition, the *integral frame limitation* and the *injection molding*

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limitation were retained in the independent claim that issued in the original patent.

Accordingly, these 3 limitations were required to obtain allowance of the original application claims. As explained in paragraph II below, 2 more limitations were also required.

II. In order to obtain allowance of the original application claims, applicants agreed to an examiner's amendment adding the following new limitations to the independent claim: (1) *"each cover has a first and second side"* from which the fingers extend (hereinafter, the *first and second sides limitation*), and (2) the *"edges of the metal covers are bent to conform to the shape of the frame..."* (hereinafter, *bent edges limitation*).

III. The original application claims to the article always recited a *"plurality of fingers"* (hereinafter, the *plurality of fingers limitation*). As noted earlier, the *plurality of fingers limitation* was relied upon in applicants' argument to define over the art. For example, the declarations made by Paul Mercadante and Mark Moshayedi in Paper No. 7, state that *"Duel's product's superiority over the other available products is due to the unique construction of the cover halves which intersperses a plastic frame within the metal elements or cover."* (Emphasis added.) On page 7 of the August 8, 1994 amendment (Paper No. 6), applicants argued that *"the declarations of Paul Mercandante and Mark Moshayedi... confirm that the product embodying this invention represents an advancement over the prior art in the field."* These passages clearly show that applicants argued and emphasized the criticality of the plurality of fingers limitation to distinguish over the prior art.

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Based on paragraphs I - III above, the following 6 elements were added (Elements 1-5) or argued (Element 6) in order to obtain allowance of the original application claims.

Element 1: the *embedded fingers limitation* (i.e., "embedded in the plastic frame elements").

Element 2: the *integral frame limitation* (i.e., "plastic frame elements forming an integral unit").

Element 3: the *injection molding limitation* (i.e., "the plastic frame elements being injection molded around the fingers").

Element 4: the *first and second sides limitation* (i.e., "each cover has a first and second side")

Element 5: the *bent edges limitation* (i.e., "edges of the metal covers are bent to conform to the shape of the frame...").

Element 6: the *plurality of fingers limitation* (i.e., "a plurality of fingers").

In the present instance, the claims which were rejected by the examiner based on prior art did not contain Elements (1-5). The claims did contain the Element (6) limitation. To overcome the prior art rejection against the claims, the applicants rewrote of the claims to add Elements (1-5) and also relied in their argument on Element (6). The applicants made the choice of inserting Elements (1-5) and specifically relying upon Element (6) for all of the claims that were allowed in the patent. **The applicant chose not to prosecute variations of the original claims not including Elements (1-6).** At the present, on reissue,

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applicant is not permitted to completely delete these elements by way of the reissue claims (the specifics of the claim deletion of elements will be explained in the next paragraph) . See *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), discussed below as to the situation where there was amendment to surrender claim subject matter. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) for the principle that limitations relied upon to define patentability, although they were not added via amendment in the original application, will establish a surrender of claim subject matter.

As explained above, elements 1-6 are the limitations relied upon to obtain allowance of the application claims and issuance of patent (i.e., the surrender-generating limitations). The reissue claims omitting these elements are as follows:

- (1) Reissue claims 7-9, 11-14, 16, and 28 do not contain element 1 (the *embedded fingers limitation*), or any intermediate thereof.
- (2) Reissue claim 24 does not contain element 4 (the *first and second sides limitation*), or any intermediate thereof.
- (3) Reissue claims 7, 10-14, 16 and 28 do not contain element 6 (the *plurality of fingers limitation*). Note: claim 28 was inadvertently left out in this paragraph in the prior office action. However, as clearly indicated in the prior office action and in numbered paragraph 5 above, this claim was rejected under 35 USC 112 1st paragraph since this claim does not positively require the plurality of fingers limitation. Therefore, claim 28 is being added in this paragraph, because this claim does not positively require element 6 (i.e. fingers).

Elements (1 – 5) of the original patent are germane to what was surrendered in response to a prior art rejection, as the independent claim was rejected over prior art until the limitations of Elements (1-5) were added. Therefore, Elements (1 – 5) of the original patent were added in order to secure a patent. Similar to the facts in *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), the applicant

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has broadened the reissue claims in an aspect germane to what was surrendered in response to the prior art rejection, and has narrowed in some aspects not related to the surrender. It is noted that the Appeal Brief states on page 21 that reissue claims 24 and 28 "*are even more narrow than the original claims by describing the frame elements as being 'sonically bonded'.*" However, there is no replacement narrowing limitation that relates to any of the five surrender-generating limitations. The decision in *Pannu* is on point as to the issues on appeal, because it provides an actual fact situation in which this scenario (claim narrowing in an unrelated area) was held to be recapture. Note also the statement in *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997) that every time the claims are narrowed by amendment, subject matter is surrendered. *Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166 ("[E]very time Clement amended his claims, he intentionally omitted or abandoned the claimed subject matter."). This statement that every time the claims are narrowed by amendment, subject matter is surrendered, calls for analyzing reissue claims for whether a key narrowing that was made in the original prosecution has abandoned, i.e., surrendered, subject matter that the patent owner is now seeking to recapture by reissue. Thus, the insertion of a narrowing unrelated to the abandoned (surrendered) claim subject matter that owner is impermissibly trying to recover does not save the claim from the recapture doctrine.

With regard to Element (6), as pointed out above, *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) is depended upon for the principle that limitations relied upon to define patentability will establish a surrender of claim subject matter, even though they were not added via amendment (in the original

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application). Again, there is no replacement narrowing limitation that relates to any of the Element (6) surrender-generating limitation.

Remarks on whether *Eggert* applies are as follows:

The facts of the recapture rejection are not analogous to the facts in *Ex Parte Eggert et al*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003).

The decision in *Ex Parte Eggert et al*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003) is inapplicable to the instant case as the surrendered subject matter does not appear in any of the claims in an intermediate form (i.e., where surrendered subject matter was omitted, it was entirely omitted). Entire omission of surrendered subject matter in a reissue claim, even if it includes other, unrelated limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. As stated in *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597, 1601 (Fed. Cir. 2001), "[o]n reissue, [the patent owner] is estopped from attempting to recapture **the precise limitation** he added to overcome prior art rejections." (Emphasis supplied).

Reasons for not Making any Prior Art Rejection

JP 02-014195 is determined to be the closest prior art. This reference is one of the prior art references cited in a) re-examination made in Canadian Intellectual Property Office (CIPO), b) an invalidation trial in Japan, and c) an invalidation trial in Korea. At the outset, one could/would not reasonably consider the recited "*plastic frame element*" to read on a plate portion of a resin base in JP '195, rather this limitation is taken to only read on a peripheral portion of the resin base. While JP '195 substantially teaches independent claim 11 (appears to be the broadest claim among the pending independent claims), this claim is taken to define over JP '195, because JP '195 does not teach "... *the plastic frame elements are injection molded to secure the fingers of each cover to the plastic frame element ...*". As clearly illustrated in figure 3, a resin peripheral portion (i.e. taken to be the recited "frame element") of a resin base element is spaced-apart from a bent portion (i.e. taken to be the recited finger). Therefore, the

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bent portion couldn't reasonably be secured by the resin peripheral portion. As for a second broadest claim 24, this claim defines over JP '195, because there is no reason in the art to modify JP '195 such that fingers are embedded in the frames. While JP 02-0164599 (this art is also applied in CIPO and invalidation trial Japan) illustrates fingers being embedded (figures 1-9), the teachings of JP '599 would not have suggested to one in the art to modify JP '195 such that the bent portions are embedded in the peripheral portions of the base elements, because JP '195 requires adhesively bonding a pair of resin base elements via the resin peripheral portion, wherein a metallic cover is integral to each of the base elements, while JP '599 teaches applying peripheral molding resin around joint edge portions of metallic members. Moreover, claim 24 is also taken to define over JP '599, because this claim requires *"the first frame element being sonically bonded to said second plastic frame element"*. This limitation is expected to intrinsically create an interface between the 1st and 2nd frame elements, while a peripheral mold 4 of JP '599 has no interface.

Response to Arguments

8. Applicant's arguments and a Mr. Wingfield's declaration filed on 08-29-05 have been fully considered but they are not persuasive.

On page 5 last paragraph to page 6 paragraph 3, Counsel argues that, those versed in the art would clearly recognized that a corresponding energy director 22 has to be a V-shaped groove, since a V-shaped energy director 20 has to mate with the energy director 22. As noted above, simply because a V-shaped energy director 20 is mated with an energy director 22, it does not necessarily mean that, the energy director 22

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must have a V-shaped groove as evidence from the teachings of anyone of Branson publication cited by Applicant (figures 1-5), (Bentley et al (US 6,054,072; col. 5 lines 1-30; figures 3 & 5), Sadowski (US 6,007,069; col. 15 lines 39-67; figures 5, 7-8 and particularly 11); and, Violette et al (US 5,129,787; col. 5 lines 54-68; figures 5-6). As for the cited definition of the word "mate", nowhere in this definition remotely states that a pair of mated elements has to be shaped such that they must have complimentary male and female configurations. Therefore, the above objections/disapproval of the proposed drawing stand.

On page 7 last full paragraph, Counsel argues that "... *Fig. 3 clearly illustrates the embodiment with at least one finger ...*". Examiner strongly disagrees. Contrary to Counsel's conclusory assertion, this figure ONLY shows a plurality of fingers. As for counsel's argument on last paragraph on page 7 to page 8 full paragraph 1 that "[t]he fact that the claim is broader than the specific embodiment shown in the specification does not raise an issue of new matter.". Examiner agrees. However, the original disclosure must reasonably convey to one in the art that Applicant has in possession the newly and broadly claimed subject matter. In the present case, the original disclosure fails to reasonably convey to one in the art that Applicant has in possession of the presently claimed subject matter of using a cover which has a single finger on the 1st and 2nd side edges. As for Counsel's argument on page 8 full paragraph 2 regarding claim 11, for the same reasons set forth above, the presently claimed subject matter of "at least one finger" raises an issue of new matter.

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On page 8 last paragraph to page 9 full paragraph 1, Counsel argues that *"There is no requirement in the law that the claims must be limited to the specific disclosed embodiment. The specification and drawings ... clearly disclose edges including fingers and the metal covers having edges bent to conform to the shape of the frame. This is what is being claimed in claim 24."* While it is true that *"The specification and drawings ... clearly disclose [each of the] edges including fingers and the metal covers having edges bent to conform to the shape of the frame"* (words inserted), this claim as presently recited as noted above reads on providing finger/fingers on all 4 sides of a cover. It is respectfully submitted that the original disclosure as a whole fails to reasonably conveyed to one in the art that Applicant has in possession the above embodiment. If it is not Applicant's intention to cover this embodiment, Applicant could readily amend this claim to positively recite that the bent edges and fingers are on 1st and 2nd sides of a cover. If amended as suggested above, Examiner would gladly withdraw the 112 1st paragraph rejection on this claim.

On page 9, Counsel basically presented similar argument as claim 24 regarding claim 28, Examiner agrees that Applicant is not required to limit the specific embodiment disclosed in the original disclosure. However, it is respectfully submitted that, it must reasonably convey to one in the art that Applicant is in possession on the presently claimed subject matter. Does Applicant agree or disagree that the claimed subject matter now read on a plurality of spaced-apart small spherical bulbs projecting from an end surface of a cover? Is it Counsel's contention that the original disclosure would reasonably convey to one in the art that applicant has in possession of a cover with a

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plurality of spaced-apart small spherical bulbs projecting from an end surface of the cover?

As for Counsel's argument regarding a declaration made by Mr. Wingfield, Counsel's attention is directed to Examiner's response set forth below to Mr. Wingfield's declaration.

On statements no. 5-6, declarant states "*... it is my opinion that the inventors had possession of a package having one or more fingers in the exemplary embodiment shown in the '857 Patent, the covers include many fingers 26 on each side. However, this disclosure would also make it clear to one skilled in the art that the inventors had possession of using one finger on the sides of the covers, which is a subset of the many fingers shown in the drawings. ... the purpose of the finger or fingers on the covers is to secure the covers to the plastic frame elements and to prevent sliding of the covers with respect to the frame elements. ...*". It is respectfully submitted that, Mr. Wingfield may be an expert in this field. However, in the determination of whether or not a claimed subject matter is sufficiently supported in an original disclosure under 35 U.S.C. 112, first paragraph, Mr. Wingfield is no more than a layperson. It would appear that, Mr. Wingfield is confusing the issue between "*in possession*" and "*obviousness*". Mr. Wingfield's conclusory statement would appear to be based on his understanding that, providing single finger to each of 1st and 2nd sides of a cover would have been obvious in the art in light of the disclosure as a whole. This, however, is not the standard. It is respectfully submitted that, **one must show that one is "in possession" of the invention by describing the invention, with all its claimed limitations, not that**

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which makes it obvious. Id. (“[T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for the purposes of the ‘written description’ inquiry, *whatever is now claimed.*”) (emphasis in original). One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc. that fully set forth the claimed invention. Although the exact terms need not be used *in haec verba*, see *Eiselstein v. Frank*, 52 F. 3d 1035, 1038, 34 USPQ 2d 1467, 1470 (Fed. Cir 1995). (“[T]he prior application need not describe the claimed subject matter in exactly the same terms as used in the claims ...”), the specification must contain as equivalent description of the claimed subject matter. A description which renders obvious the invention for which an earlier filing date is sought is not sufficient. As correctly noted by Mr. Wingfield, “...*the exemplary embodiment shown in the ‘857 Patent, the covers include many fingers 26 on each side*”. As for Mr. Wingfield explanation of a single finger functioning equivalently as a plurality of fingers, it should be re-emphasized that, not only Applicant argued the importance of fingers, Applicant provided two separate declarations stressing the criticality of fingers. Accordingly, in one of the two declarations, it states “*Duel’s product’s superiority over the other available products is due to the unique construction of the cover halves which intersperses a plastic frame within the metal elements or cover.*” (Emphasis added.). How can a plastic frame intersperses within the metal elements when each of 1st and 2nd sides of a metallic cover only has a finger? Therefore, a finger does not completely function equivalently with fingers. In any event,

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even for the sake of argument Mr. Wingfield is correct, simply because a newly claimed subject matter (a single finger) functions equivalently with a plurality of fingers, it does not necessarily mean that Applicant has in possession of this claimed subject matter. Mr. Wingfield has simply failed to provide any reasonable basis on why the original disclosure as a whole would have reasonably conveyed to one in the art that applicant has in possession the presently claimed subject matter of a single finger as opposed to a plurality of fingers.

As for declarant's statements no. 7-8 regarding a cover having a U-shaped edge, only claim 28 requires this limitation. This claim, however, is rejected under 35 USC 112 1st paragraph not because the cover has a U-shaped edge, but rather, this claim does not require the 1st and 2nd side portions of each cover having plurality of fingers. As noted above, the recited protruding portions limitation in this claim read on a plurality of spaced-apart small spherical bumps.

On pages 11-12, Counsel basically made the following argument regarding the rejection of claims under 35 USC 251: *"... the present claims while broader than the issued claims are narrower than the finally rejected claims and therefore, fall within the gray "donut" area of the drawing used by the Board in the Eggert case to illustrate the permissible scope of broaden reissued claims."* (quotation in original). It is quite clear that, Counsel's reliance of the Eggert case is off-point. Counsel is completely ignoring the fact the surrendered subject matter does not appear in any of the claims in an intermediate form. In other words, the surrendered subject matter was entirely omitted.

Entire omission of surrendered subject matter in a reissue claim, even if it

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includes other, unrelated limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. As stated in *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597, 1601 (Fed. Cir. 2001), "[o]n reissue, [the patent owner] is estopped from attempting to recapture **the precise limitation** he added to overcome prior art rejections." (Emphasis supplied). Similar to the facts in *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), the applicant has broadened the reissue claims in an aspect germane to what was surrendered in response to the prior art rejection, and has narrowed in some aspects not related to the surrender. Moreover, with regard to Element (6), as pointed out above, *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) is depended upon for the principle that limitations relied upon to define patentability will establish a surrender of claim subject matter, even though they were not added via amendment (in the original application). Again, there is no replacement narrowing limitation that relates to any of the Element (6) surrender-generating limitation. Furthermore, in *Hester*, supra, the Federal Circuit held that the surrender which forms the basis for impermissible recapture "*can occur through arguments alone*". 142 F.3d at 1482, 46 USPQ2d at 1649. In the present case, not only Counsel stressed the importance of providing fingers to each of 1st and 2nd sides, Applicant has submitted two separate declaration emphasizing the criticality of fingers in Applicant's invention.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
10-11-05